

### REMARKS

Claims 1, 2, 4-9 and 23-25 are pending in the application, of which claims 1 and 2 have been amended. No new matter has been added as a result of the above amendments. Reconsideration of the pending claims is respectfully requested in light of the foregoing amendments and the following remarks.

#### Allowable Subject Matter

Claims 7-9 have been allowed.

#### Rejections Under 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,900,135 to Somekh et al., hereinafter referred to as "Somekh". Applicants respectfully traverse the Examiner's position for the following reasons.

The PTO provides in MPEP § 2131 that

*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

With regard to claim 1, Applicants submit that Somekh fails to teach every element of that claim. Claim 1, as currently amended, recites:

*A method of manufacturing a microelectronic device, comprising:  
performing a first inspection of a device feature formed on a substrate during an intermediate stage of manufacture;  
cleaning the device feature after the first inspection; and  
performing a second inspection of the device feature after cleaning the device feature, wherein the first and second inspections are performed by a single inspection tool.*

Applicants submit that Somekh fails to anticipate claim 1 as amended because Somekh fails to teach all of the features recited therein. In particular, Somekh fails to teach or suggest "performing a first inspection of a device feature formed on a substrate" as recited in claim 1. On the contrary, Somekh is directed to solving problems inherent in cleaning and inspecting the backside of a wafer (*see, e.g.*, column 1, line 63-column 2, line 7). Somekh is devoid of any teaching of cleaning and inspecting a device feature formed on the substrate, presumably on the top side thereof. As pointed out in Somekh, examination and cleaning of the backside of a wafer during manufactures presents certain unique problems that are specifically addressed by the invention described in that reference. Thus, the invention of Somekh is specifically directed toward those problems and cannot appropriately be applied to

performing an inspection of a device feature, which is disposed on the topside of a wafer. Accordingly, it is apparent that Somekh does not anticipate claim 1, as it fails to teach every element thereof.

### **Rejections Under 35 U.S.C. § 103**

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of U.S. Patent No. 6,410,927 to Pike, hereinafter referred to as "Pike". Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of U.S. Patent No. 6,512,227 to Iwabuchi et al., hereinafter referred to as "Iwabuchi". Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of U.S. Patent No. 6,841,008 to Branco et al., hereinafter referred to as "Branco". Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of U.S. Patent No. 6,355,516 to Kim et al., hereinafter referred to as "Kim". Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of Pike. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of Pike and further in view of Branco. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Somekh in view of Pike and further in view of Kim.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. . .*

It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

**1. Even when combined, the references do not teach the claimed subject matter.**

The Somekh and Pike patents cannot be applied to reject claim 2 under 35 U.S.C. § 103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 2, as amended, recites:

*A method of manufacturing a microelectronic device, comprising:  
performing a first inspection of a device feature **formed on a substrate** during an intermediate stage of manufacture;  
cleaning the device feature after the first inspection; and  
performing a second inspection of the device feature after cleaning the device feature,  
wherein the first inspection is performed by a first inspection tool and the second inspection is performed by a second inspection tool different than the first inspection tool.*

For the reasons indicated above with respect to the allowability of claim 1, Somekh fails to teach, suggest, or render obvious “performing a first inspection of a device feature formed on a substrate”, as recited in claim 2. Pike, which is cited by the Examiner for its teaching of performing first and second inspections using two different inspection tools, fails to remedy the deficiencies of Somekh in this regard. Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 2 under 35 U.S.C. §103 should be withdrawn.

**2. The combination of references is improper.**

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly not the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the Somekh and Pike patents cannot be applied to reject claim 2 under 35 U.S.C. §103.

§2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.*

Here, neither Somekh nor Pike teaches, or even suggests, the desirability of combining the use of two different inspection tools, as taught by Pike, with the teachings of Somekh as specified above and as recited in claim 2. On the contrary, it would appear from the teachings of Somekh that a primary benefit of the invention described therein is that the cleaning and inspection may be performed using a single tool. Therefore, it would be antithetical to the teachings of Somekh to perform a second inspection using a second, and different, tool, as described in Gardner.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 2. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Claims 4-6 depend from and further limit independent claim 1, in a patentable sense, and are therefore deemed to be in condition for allowance for the reasons set forth above with respect to the allowability of claim 1.

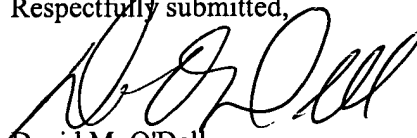
Claims 23-25 depend from and further limit independent claim 2, in a patentable sense, and are therefore also deemed to be in condition for allowance for the reasons set forth above with respect to the allowability of claim 2.

**Conclusion**

Claims 7-9 have been allowed. For the reasons set forth in detail above, claims 1 and 2 are deemed to be in condition for allowance. Claims 4-6 and 23-25 depend from and further limit independent claims 1 and 2 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

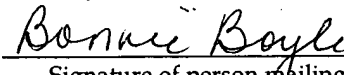
An early formal notice of allowance of claims 1, 2, 4-6, and 23-25 is respectfully requested.

Respectfully submitted,

  
David M. O'Dell  
Registration No. 42,044

Dated: February 14, 2006

HAYNES AND BOONE, L.L.P.  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 972/739-8635  
Facsimile: 214/200-0853  
Client Matter No.: 2002-1398 / 24061.187  
D-1406298.01

<p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450</p> <p>on: <u>February 14, 2006</u></p> <p> Signature of person mailing paper and fee</p>
---